UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,560	11/25/2003	Nicholas Frank Ciminello	END920030109US1	5820

49389 7590 09/14/2006

PASTEL LAW FIRM
8 PERRY LANE
ITHACA, NY 14850

EXAMINER	
PICKETT, JOHN G	

ART UNIT	PAPER NUMBER
3728	

DATE MAILED: 09/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/721,560	CIMINELLO ET AL.	
	Examiner	Art Unit	
	Gregory Pickett	3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 November 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-9* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *25 November 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *1/5/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

1. Claims 4-6 are rejected under 35 U.S.C. 102(a) as being anticipated by Prior Art Figure 1 of the instant application (hereinafter PA1).

In accordance with MPEP 2111.01, during examination, the claims must be interpreted as broadly as their terms reasonably allow. *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1369, 70 USPQ2d 1827, 1834 (Fed. Cir. 2004). As presented, claim 4 does not positively recite the cassette as claimed structure. The claim is read to recite a dome having a plurality of dome engagement means for engaging with a cassette of a specific structure; the cassette is only recited in "intended use" form.

As such, PA1 discloses a dome **10** having a plurality of dome engagement means **12**, that are fully capable of engaging a cassette of the claimed structures, including those having a secondary engagement means of a number equal to, or less than a number of primary engagement means.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Prior Art Figures 1, 2, and 6 of the instant Application (hereinafter PA1, 2, & 6) in view of Lyons (US 5,829,591).

Claim 1: PA1, 2, & 6 discloses a reticle SMIF pod with a dome **10** having a plurality of latchkeys **12**, and a cassette **14'** having a plurality of primary engagement locations **18'** that are intended to receive the plurality of latchkeys. PA1, 2, & 6 discloses the claimed invention except for the secondary engagement locations.

Lyons teaches a receptacle **10** with a base **12** and a cover **14**, wherein the base has a plurality of primary engagement locations (slots **18** closest to bottom **16**) and a plurality of secondary engagement locations (slots **18** located above those closest to bottom **16**) for the purpose of variable volume (see for example Col. 2, lines 27-32). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the pod of PA1, 2, & 6 with additional engagement locations as taught by Lyons in order to vary the volume of the pod. It has been held that the provision of adjustability, where needed, involves only routine skill in the art. *In re Stevens*, 101 USPQ 284 (CCPA 1954).

As to claims 2 and 3: At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to provide the secondary slots in the claimed numbers because applicant has not disclosed that the specific numbers provide an advantage, are used for a particular purpose, or solve a stated problem. One of ordinary skill in the art, furthermore, would have expected applicant's invention to perform equally well with any number of secondary engagement

locations because applicant readily admits as such (see specification at paragraph [021]).

Therefore, it would have been an obvious matter of design choice to modify the pod of PA1, 2, & 6-Lyons with the claimed number of secondary engagement locations to obtain the invention as specified in claims 2 and 3.

Claim 4: If a narrow interpretation of claim 4 is taken to mean the cassette is inclusive, PA1, 2, & 6-Lyons, as applied to claim 1 above, discloses the claimed invention.

Claims 5 and 6: PA1, 2, & 6-Lyons, as applied to claims 2 and 3 above, discloses the claimed invention

Claim 7: The active method step claimed is the provision of structure, namely a plurality of secondary latchkey receivers. PA1, 2, & 6-Lyons, as applied to claim 1 above, discloses the claimed method step upon presentation. As the latchkey of PA1, 2, & 6-Lyons is spring loaded, the pod is inherently capable of preventing the cassette from completely disengaging from the dome if the latchkeys fail to engage the primary latchkey receivers.

Claims 8 and 9: No active method steps are presented. It has been held that to be entitled to weight in method claims, the recited structure limitations therein must affect the method in a manipulative sense, and not to amount to the mere claiming of a use of a particular structure. *Ex parte Pfeiffer*, 1962 C.D. 408 (1951). Accordingly, PA1, 2, & 6-Lyons, as applied to claims 2 and 3 above, discloses the claimed invention

Conclusion

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references show variable volumes by means of additional engagement locations.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 571-272-4560. The examiner can normally be reached on Mon-Fri, 11:30 AM - 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

GP

Greg Pickett
Examiner
11 September 2006